

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested.
Claims 1-5 are pending in this application. Claims 1-5 stand rejected.

Rejection under 35 U.S.C. §112, second paragraph

In the final Office Action, claim 5 was rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness regarding the terminology “gothic arc”. In the current Amendment, the terminology “gothic arc shape” has been removed from claim 5.

In view of the above-noted amendment, it is believed that claim 5 particularly points out and distinctly claims the subject matter which applicant regards as the invention in accordance with the requirements of §112, second paragraph. Reconsideration and withdrawal of the rejection under §112, second paragraph, are respectfully requested.

Claim Rejections – 35 U.S.C. §103

In the final Office Action, claims 1-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Akeno** (JP 07-181275, previously cited) in view of **Michioka et al.** (USP 6,155,717, previously cited).

Initially, it is noted that claim 1 has been amended to clarify certain features related to the claimed “lubricator”. In particular, claim 1 has been amended to clarify the portions of the lubricator that contact the cylindrical shaft. Further, claim 1 has been amended to clarify the claimed “opening” formed in the “lubricator”.

In the Request for Reconsideration filed on October 27, 2009, it was argued that the combination of references does not disclose or suggest “a lubricator having applicators for applying lubricant only to contact portions of the [cylindrical] shaft with the driving roller and the driven roller.” In particular, in the Request for Reconsideration, it was emphasized that **Michioka**, which is the only reference teaching a lubricator having applicators, cannot teach applying lubricant only to contact portions of a cylindrical shaft with driving and driven rollers because **Michioka** does not teach a cylindrical shaft. In the Advisory Action mailed on January 25, 2010, the Examiner asserts that **Michioka** teaches a linear movement device that is similar to the claimed invention because it moves linearly (see Continuation Sheet, lines 8-11).

However, it is respectfully submitted that the fact that **Michioka** moves linearly ignores the basis of one of the distinctions between **Michioka** and the claimed invention, that is, the portions of the cylindrical shaft to lubricant is applied by the lubricator. In this connection, claim 1 has been amended to clarify the operation of the lubricator vis-à-vis the cylindrical shaft. In particular, claim 1 recites “*a lubricator having applicators which contact only axial portions of a surface of the shaft that are contacted by the driving roller and the driven roller to apply lubricant to said axial portions*”. See, for example, page 15, lines 9-13 of the specification as originally filed.

It is submitted that the combination of references does not disclose or suggest “*a lubricator having applicators which contact only axial portions of a surface of the shaft that are contacted by the driving roller and the driven roller to apply lubricant to said axial portions*”.

Furthermore, in the Request for Reconsideration, it was argued that the combination of **Akeno** and **Michioka** does not disclose or suggest “wherein said lubricator has an opening which is formed in a side of said lubricator and which has such a shape and a size as to allow said lubricator to be attached to and detached from said shaft, and wherein said lubricator is allowed to be attached to and detached from said shaft through said opening in a direction perpendicular to the axial direction of said shaft”. In response to this argument, in the Advisory Action, the Examiner asserts that the language “to allow” is functional and only requires the capability to perform a function.

In this connection, claim 1 has been amended to clarify aspects of the invention by reciting “*wherein said lubricator has an opening which is formed in a side of said lubricator to open both in the axial direction of said shaft and in a direction perpendicular to said axial direction and which has such a shape and a size as to enable said shaft to be inserted into and removed from said opening*”.

The Examiner’s point is appreciated that the language “to allow” only requires that the prior art be capable of performing the function following the language “to allow”. That is, the prior art only has to be capable of allowing that function to be performed.

However, as was argued in the Request for Reconsideration, the structure of the **Michioka** lubricant supplying member 4 is such that it can be detached from the track 1 *in a direction perpendicular* to the track 1 only by breaking the lubricant supplying member 1 rendering the lubricant supplying member unsuitable for use. It is well established that a modification of a reference that destroys its intent, purpose or function does not establish a *prima*

facie case of obviousness. See the Manual of Patent Examining Procedure (MPEP) §2143.01 V., which states "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

It is submitted that if the lubricant supplying member 4 of **Michioka** is allowed to be detached in a direction perpendicular to the track 1 the lubricator 4 would break, thereby rendering it unsatisfactory for its intended purpose. Also, it is noted that the Advisory Action does not address the fact that the **Michioka** reference would be destroyed if modified as suggested in the rejection.

A rejection under §103 requires that the combination of teachings applied against the claims must disclose, suggest or render obvious all elements recited in the claims. As discussed above, it is respectfully submitted that the combination of **Akeno** and **Michioka** do not disclose, suggest or render obvious all elements recited in dependent claim 1. Further, to meet the claim limitations, the function of the **Michioka** device would be destroyed. Therefore, it is respectfully submitted that a *prima facie* case of obviousness has not been made and that claim 1, and claims 2-5 which depend therefrom, patentably distinguish over the cited combination of references. Accordingly, reconsideration and withdrawal of the rejection under §103 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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